

## **II. REMARKS**

### **A. STATUS**

In this reissue application, claims 1-17 and 19-35 are pending. Claims 1, 2, and 7-9 are allowed. Claims 20-30 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. §112 ¶ 2 the Patent Examiner cited. (Office Action, p. 4)

Claims 3-6, 16, 17, and 19 stand rejected under 35 U.S.C. § 112 ¶ 2 by the Patent Examiner. Claims 31-34 stand rejected under 35 U.S.C. § 112 ¶ 1 by the Patent Examiner.

Claims 10-17 and 19-35 stand rejected as being based on a defective reissue Oath.

Claims 10-17 and 19-35 stand rejected as further being improperly broadened in a reissue application sworn by the assignee and not the patentee.

Claims 10-15 and 35 stand rejected under 35 U.S.C. §102(a) and/or 35 U.S.C. §102(b) as being anticipated by US Patent 5,383,829 to Miller (“Miller I”) and/or US Patent 5,242,343 to Miller (“Miller II”) (collectively, “Miller”).

Claims 33-34 stand rejected under 35 U.S.C. §103(a) as being rendered obvious by either Miller I or Miller II in view of Breunig.

### **B. The Final Rejection Status Is Premature And Thus Improper**

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” MPEP §706.07(a).

The Patent Examiner rejected claims 3-6 under 35 U.S.C. §112 ¶ 2. (Office Action, p. 4, ¶ 9) Claims 3-6 were, until this Office Action response, in their original form. At no prior time did the Patent Examiner reject these claims under 35 U.S.C. §112 ¶ 2. (See, e.g. Doc. 10

(allowing then pending claims 1-30)) Accordingly, rejection of Claims 3-6 under 35 U.S.C. §112 ¶ 2 introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement. Applicants respectfully request withdrawal of the finality of the rejection. MPEP §706.07(d).

**C. Amendments To Claims**

Original Claim 3 and new Claims 10, 16, and 20 were amended.

Claim 3, which Applicants respectfully point out had been approved for issue twice before as originally worded, was amended to more clearly state what the rules of grammar already made clear: the first and second linkage arms that are of unequal length are the first arm and the second arm of the second linkage of Claim 2.

Claim 10 was amended to clarify that which was already clear, i.e. that (a) there are two foot supports, (b) each of the first foot support and the second foot support are part of a foot supporting linkage assembly that is pivotally connected to a reciprocating member proximate a first end of the reciprocating member, and (c) the foot supports are further movable to circumnavigate a generally elliptical path.

Claim 16 was amended to more clearly indicate that the first location is at the pivot axis.

Claim 20 was amended to merely fix a scrivener's error: "an" was a typographical error and should have been "on."

As before, for the Patent Examiner's ease of examination, the following changes to reissue claims were made as indicated in the table below:

CLAIM	PREVIOUS LANGUAGE	NEW LANGUAGE
3	the first and second linkage arms are of unequal length	the first arm and the second arm of the second linkage are of unequal length
10	a first foot supporting linkage assembly	a first foot supporting linkage

	<p>pivotaly connected to said first reciprocating member proximate said first end of said first reciprocating member; and</p> <p>a second foot supporting linkage assembly pivotaly connected to said second reciprocating member proximate said first end of said second reciprocating member;</p> <p>wherein each foot of the user of the device is movable to circumnavigate a generally elliptical path</p> <p>movable through</p>	<p>assembly pivotaly connected to said first reciprocating member proximate said first end of said first reciprocating member, <u>the first foot supporting linkage assembly comprising a first foot support</u>; and</p> <p>a second foot supporting linkage assembly pivotaly connected to said second reciprocating member proximate said first end of said second reciprocating member, <u>the second foot supporting linkage assembly comprising a second foot support</u>;</p> <p>wherein each of <u>the first foot support and the second foot support</u> is movable to circumnavigate a generally elliptical path.</p> <p>movable to circumnavigate</p>
13	movable through	movable to circumnavigate
16	<p>a first rocker link and a second rocker link, wherein each said rocker link is mounted on the frame and pivotal relative thereto about a pivot axis</p> <p>movable through</p>	<p>a first rocker link and a second rocker link, wherein each said rocker link is mounted on the frame and pivotal relative thereto about a pivot axis at a first location</p> <p>movable to circumnavigate</p>
20	a crank mounted on the frame and rotatable about a crank axis relative to the frame	a crank mounted on the frame and rotatable about a crank axis relative to the frame
24	<p>movable through at least one left link and the left foot support,</p> <p>at least one right link and the right foot support</p>	<p>movable to circumnavigate a left link and a second left link, the left foot support movably connected to a discrete portion of the second left link a right link and a second right link, the right foot support movably connected to a discrete portion of the second right link</p>
25	the frame, the	the frame and the
26	movable through	movable to circumnavigate
28	apparatus direction; and	frame direction;

	member; wherein a resistance device is connected to at least one said crank and operable to resist rotation of said crank	member; and a resistance device operably connected to at least one said crank to resist rotation of said crank
31	a first crank movable through	a lockable first crank movable to circumnavigate
32	movable through	movable to circumnavigate
33	left and right cranks supports through	lockable left and right cranks supports to circumnavigate
34	left and right cranks	lockable left and right cranks

These amendments comply with 37 C.F.R. §1.173(b). No new matter was added while making these corrections.

**D. The Oath Is Not Defective**

The Patent Examiner rejected the Oath for two different reasons. Applicants respectfully traverse.

**1. The December 1997 Version Of Rule 1.175 Applies To This Application**

The Patent Examiner states “Although Rule 1.175 changed, the more recent rules still apply.” (Office Action, p. 9) Applicants respectfully submit that their argument is more or less exactly that: the more recent Rule 1.175, which became effective December 1, 1997, applies to the current reissue application. *Shockley v. Arcan, Inc.*, 248 F.3d 1349, 1359 (Fed. Cir. 2001) (“Because the application which led to the ‘732 reissue patent was pending when the new rule took effect, the new rule applies in this case.”)

As discussed previously, the Patent Examiner rejected the original Oath in the First Office Action on the merits in January 1999 but the rationale for such rejection was in error, citing to the old rule. (Doc. 7, Office Action dated January 16, 1999) In tacit recognition of this, the Patent Examiner allowed claims 1-30 without any further requirement that the Oath be corrected. (Doc. 10, Office Action dated July 26, 2000).

After many years delay and after further additional amendments, the Patent Examiner again argued that the Oath is defective. (Office Action dated June 19, 2007) In that Office Action, the Patent Examiner again cited to the old Rule and not the new. (Office Action, pages 3-4)

## **2. The Oath States At Least One Particular Reissue-Related Error**

The Patent Examiner states that the Oath is defective because it does not state at least one particular error. (Office Action, p. 2) The Patent Examiner also asserts that the “having once stated an error” does not apply. (Office Action, p. 9) However, the original Oath did indeed state at least one error.

A Reissue Applicant need only specify one of the errors upon which reissue is based in the reissue oath/declaration. MPEP §1414(II)(b).<sup>1</sup> Two errors were pointed out: (1) the patent did not claim invention in terms that Rodgers did<sup>2</sup> and (2) the patent did not claim a foot support constrained to a regulated movement in a first direction and an unregulated movement in generally orthogonal direction. The Patent Examiner objects to these as errors in part because he asserts that “regulated” and “unregulated” do not appear in the claims and requests that the Applicants specifically point out where callout “C” appears. (Office Action, p., 9)

These words need not appear *per se* but, as noted before, at all relevant times, word-for-word correspondence is not required between the reissue declaration and the actual changes

---

<sup>1</sup> The Patent Examiner further asserts that it is improper to state in the declaration that the errors were due to claim language absent in the parent applicant and that the declaration must address an error in which the parent claims were too limiting, pointing out that limiting structure. (Office Action, page 4 (emphasis added)) As discussed more fully below, this is not the case as the claims can properly be broadened in this application and Rule 1.175(a)(1) allows such a reissue if the “patentee [claimed] more or less than the patentee had the right to claim in the patent. (emphasis added)”

<sup>2</sup> These were elucidated in the co-filed request for an interference, on page 2.

made in the reissue application. *Dethmers Mfg. Co., Inc. v. Automatic Equipment Mfg Co.*, 271 F.3d 1365, 1370 (Fed. Cir. 2001). In fact, the Patent teaches:

Each such articulated linkage has a generally vertical linkage that is pivotally coupled to the frame and a generally horizontal linkage that is pivotally coupled to its respective foot pedal. These linkages, each of which may comprise a single or a pair of linkage arms, are pivotally coupled to one another such that each foot pedal is free to move within a two-dimensional envelope of motion in a vertical plane.

(Patent, Col. 1, ll. 59-62) The specification also teaches:

An optional feature of the present invention is to provide a source of power, such as a D.C. motor, for roller 80 so that the horizontal stroke between positions B and C is powered, much in the manner of a treadmill.<sup>3</sup> When operating in this mode, the individual expends energy to keep pace with retreating foot pedal 26, but is not applying muscular energy to force it backward as in the unpowered<sup>4</sup> mode. With the option of supplying power to roller 80, it is desirable to have an unpowered idler roller 82 immediately behind roller 80 so that the terminal portion of the horizontal stroke is unpowered. This is important for safety considerations and also provides a more pleasing feel to the exercise. It will be seen that as the horizontal stroke proceeds from position B to position C, horizontal linkage member 32 “tips over” roller 80 to engage roller 82 and thereby disengage from roller 80.

(Patent, Col. 4, ll. 51-65; *see, e.g.*, claims 20, 24) The specification goes on to teach:

Furthermore, the resistance for each component of motion may be the same, or resistance to horizontal motion may be a predetermined percentage of the resistance to vertical motion, or each component may be separately adjusted or eliminated entirely. Also, as just discussed, the horizontal component of motion may be powered in a backward direction in the manner of a treadmill, which may be used in combination with any desired resistance to the vertical component of motion.

(Patent, Col. 5, ll. 2-10; *see, e.g.*, claims 20, 24).

Thus, the errors identified in the substitute declaration are errors on which this reissue application can be based.

---

<sup>3</sup> *E.g.*, regulated.

<sup>4</sup> *E.g.*, unregulated.

### **3. The Claims May Be Broadened**

As noted before, U.S. Patent No. 5,449,956, upon which this reissue application is based, issued March 19, 1996. The present application for reissue was filed November 11, 1997, within two years after the grant date. With respect to claims 1-35 (and ignoring claims 36-64), all claims after 9 were added during the current reissue application process. Thus, its newly sought claims, filed within two years after grant, can be broader than those originally granted.<sup>5</sup> 35 U.S.C. § 251 (party can broaden claim if reissue request filed within two years after grant).

Accordingly, claims were added to this reissue application which was filed before the expiration of the two years from issue time frame and were accordingly properly broadened. Thus traversed, Applicants respectfully ask the Patent Examiner to withdraw the assertions as to the claims being improperly broadened on page 4 of the Office Action.

### **4. The Time And Intent Elements Are Satisfied By The Oath**

A Reissue Oath is required to assert that "All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant. (emphasis added)"

This Application for Reissue was filed in November 1997. The Oath is dated in April 1998 and was submitted in May 1998.

### **5. A Supplemental Oath, If Needed, Is Timely If Filed Before Allowance**

The Patent Examiner disagrees with the statement made by Applicants that a supplemental oath or declaration may be submitted before allowance. Respectfully, the Patent

---

<sup>5</sup> As noted before, claims 1-30 (as then amended) were allowed on July 26, 2000 but the reissue patent never issued, for reasons unknown. (Doc. 10) On January 18, 2001, in a follow-up office status correspondence, claim 18 was deleted and various claims amended. On September 22, 2004, having heard nothing further from the Patent Examiner and with the application still pending, some claims were further amended and claims 36-64 added.

Examiner's distinction between 37 CFR 1.175(b)(1)(i) and 37 CFR 1.175(b)(1)(ii) is misplaced.

37 CFR 1.175 (b)(1) states

For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

- (i) With any amendment prior to allowance; or
- (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

37 CFR 1.175 (b)(1)(all emphasis added). The MPEP itself, at §1444, states:

A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

MPEP §1444 (emphasis in original) Thus, (1) Rule 1.175(b)(1) only requires that any supplemental oath or declaration must be submitted before allowance and (2) the MPEP makes no distinction between the subparts to 37 CFR 1.175(b)(1).

Applicants herewith respectfully submit that they are obtaining a further supplemental declaration. Thus traversed, Applicants respectfully ask the Patent Examiner to withdraw the assertions as to the declaration being defective stated on pages 3-4 of the Office Action.

#### **E. Objection to the Drawings**

The drawings were objected to under 37 CFR 1.83(a) as not showing a lockable crank as claimed in claims 31-34. Applicants respectfully traverse this objection. FIG. 3 schematically shows the lockable crank assembly 120. Applicant is not claiming any specific details of the locking mechanism of the locking crank assembly, so it is not necessary to include such additional details thereof in the schematic drawing of the lockable crank assembly.



**F. Rejections Under 35 U.S.C. §112**

Claims 3, 16, and 20 were amended to overcome the Patent Examiner's objections under 35 U.S.C. §112. In all of these amendments, no new matter was added. The amendments to the claims accordingly render the §112 rejections moot.

**1. Figure 3 Does Not Limit Claims 3-6 As Asserted**

The Patent Examiner appears to have rejected Claims 3-6 under 35 U.S.C. §112 because these claims "are not supported by the figure 3 embodiment." (Office Action dated 08-21-2008, p. 4). Applicants respectfully traverse.

First, Claims 1-6 were allowed during the prosecution of the original patent. 37 CFR 1.176(b) recites, "(b)Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (**restriction involving only subject matter of the original patent claims will not be required**). [emphasis added]" Claims 1 and 3 to 6 were subject matter of the original patent. Under Rule 176(b), the Examiner does not have authority to now require restriction between claim 1 and claims 3-6, which were all subject matter of the original patent.

Second, the Patent Examiner's current statement that "Claim 1 is nongeneric" is not accurate. In the restriction requirement (Doc. 2), the Patent Examiner specifically noted that "claims 1 and 3 are [both] **generic**." (Doc. 2, p. 2 (emphasis added)). Even assuming, for purpose of argument, that the Examiner no longer believes claims 1 and 3 to be generic, Rule 176(b) does not make an exception for subject matter of the original patent where the Examiner changes his position in that regard during reissue.

Third, Fig. 3 merely augments Fig 1. In discussing Fig. 1, the specification teaches that "Foot pedals 26 are preferably biased towards an upward and forward position which provides a convenient starting position for the exercises that may be performed utilizing apparatus 10. A

spring 42 is attached to a tab 44 which in turn is secured to base member 16.” (Patent, Col. 3, ll. 16-20) The patent (and its attendant reissue application) specifically note that “FIG. 1 is a overall perspective view of an apparatus according to the present invention” and “FIG. 3 diagrammatically illustrates a **modification** of the present invention as shown in FIG. 1.” (Patent, Col. 2, ll. 21-26 (emphasis added)). Fig. 3 is therefore not the complete rendition of that which is shown in Fig. 1 but, rather, is an illustration of an exemplary modification. Thus, that spring 44 is not shown in Fig. 3 is immaterial, as Fig. 3 did not eliminate the option of having a spring as illustrated in Fig. 1 which Fig. 3 merely modifies.

**2. The Specification Enables One Of Ordinary Skill To Practice Lockable Cranks**

The Patent Examiner asserts that the specification does not disclose how a “lockable crank” is accomplished, e.g. as claimed in Claims 31-34. (Office Action dated 08-21-2008, p. 5) Applicants respectfully traverse.

Under 35 U.S.C. §112 ¶ 1, “The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable **any person skilled in the art** to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [emphasis added].” As recited in M.P.E.P. § 2163.03, “Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such

descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Applicants respectfully note that the Patent Examiner has not defined who one ordinarily skilled in the art would be with respect to this application. This is discussed in more detail in Section II(F).

However, the recitation of the lockable crank was clearly set forth in the original application as filed at page 3, lines 9-11 and pages 11 lines 1-4. Further, the configuration and operation of the locking embodiment were clearly in possession of the inventor, as evidenced by the discussion in the latter passage: “If the crank assembly is locked in position, the vertical linkage arms remain stationary (preferably with both arms parallel) and the only exercise movement possible is vertical movement of the horizontal linkage arms 32’, 34’, thereby providing a simulation of stair climbing.” Further still, lockable cranks were known before applicant’s filing date (*see, e.g.*, U.S. Patent 4,841,757), so that the express reference to a lockable crank assembly would have been sufficient written description to enable one of ordinary skill in the art to practice the claimed invention. *See, e.g., Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 2008 U.S. App. LEXIS 6786 at \*17 (Fed. Cir. March 31, 2008), *citing Genentech Inc. v. Novo Nordisk of N. Am. Inc.*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (specification that enables invention will teach those ordinarily skilled in the art to make and use full scope of claimed invention without undue experimentation).

There are multiple methods by which the requisite locking can occur. Locking movable crank assemblies was well known in the art and the details are properly omitted. (*See, generally*, Patent, Col. 1, ll. 16-45 (discussion of prior art)). Even so, the specification teaches that “The crank assembly may be locked in position to operate the machine purely as a stair-climbing

simulator without a horizontal component of motion.” (Patent, Col. 2, ll. 15-17) The specification further teaches that “linkage arms remain stationary (preferably with both arms parallel) and the only exercise movement possible is vertical movement of the horizontal linkage arms 32’, 34’, thereby providing a simulation of stair climbing.” (Patent, Col. 5, ll. 38-41; Fig. 3)

Accordingly, the application as filed proved that the inventor was in possession of the inventions of claims 31-34 as now claimed. Withdrawal of the written description rejection is respectfully requested.

**G. Rejections Under 35 U.S.C. §102**

Claims 10-15 and 35 stand rejected under 35 U.S.C. §102(a) and/or 35 U.S.C. §102(b) as being anticipated by US Patent 5,383,829 to Miller (“Miller I”) and/or US Patent 5,242,343 to Miller (“Miller II”), which is a continuation of Miller I. Applicants respectfully traverse.

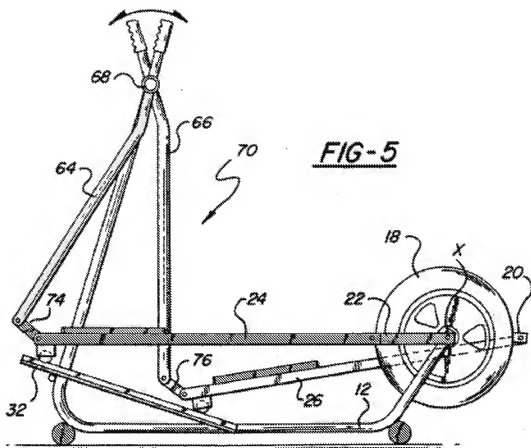
Anticipation under 35 U.S.C. § 102 requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). As the disclosures in Miller I and Miller II are identical, Applicants will refer to them jointly as Miller.

Applicants respectfully note that the Patent Examiner accepted Applicants’ traversal of Claims 16, 17, 19, 20-31 under 35 U.S.C. §102.

**1. Miller Does Not Anticipate Claim 10**

The Patent Examiner asserts that Miller’s closed loop can circumnavigate a myriad of geometric shapes and that the user of Miller’s device inherently determines the movement. (Office Action dated 08-21-2008, p. 7) The Patent Examiner also asserts that the phrase

“circumnavigate a generally elliptical path” is meaningless. (*Id.*) Applications respectfully traverse.



The Patent Examiner asserts that cranks (22 shown in green in Fig. 5 reproduced above), rocker links (64 shown in yellow in Fig. 5 reproduced above), rigid members (24 or 74 shown in blue in Fig. 5 reproduced above), and foot supports (shown in brown without callouts in Fig. 5 reproduced above; foot retaining pads 44 in Fig. 1 and Col. 3, lines 38-41)) are disclosed in Miller.

As amended, Claim 10 requires that each of the first foot support and the second foot support are part of a foot supporting linkage assembly that is pivotally connected to a reciprocating member proximate a first end of the reciprocating member on a respective rocker link and are further movable to circumnavigate a generally elliptical path. Miller’s foot supports

(foot retaining pads 44) are not part of foot supporting linkage assembly pivotally connected to a reciprocating member proximate a first end of the reciprocating member but are, instead, on the “rigid member” foot link 24. (See Miller, Fig. 1; Fig. 3; Fig. 4; Fig. 5). Accordingly, every element and limitation of Claim 10 are not found in Miller, arranged as in claim 10. Miller is therefore not an anticipatory prior art reference per 35 U.S.C. §102.

#### **H. Rejections Under 35 U.S.C. §103(a)**

Claims 33-34 stand rejected under 35 U.S.C. §103(a) as being rendered obvious by Miller or Miller in view of Breunig. Applicants respectfully traverse.

##### **1. The Rejection Does Not Comply With The US Supreme Court’s Mandates On Obviousness Rejections**

The Office Action does not list or mention the four factual inquiries mandated by the United States Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966) for determining whether a claimed invention is obvious under 35 U.S.C. § 103. More recently, the Supreme Court held that the four Graham factors “continue to define the inquiry that controls” under 35 U.S.C. § 103. *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The factual determinations underpinning the legal conclusion of obviousness include 1) the scope and content of the prior art, 2) the level of ordinary skill in the art, 3) the differences between the claimed invention and the prior art, and 4) evidence of secondary factors, also known as objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18; *Eisai Co. Ltd. v. Dr. Reddy’s Laboratories, Ltd.*, 2008 U.S. App. LEXIS 15399 at \*4-5 (Fed. Cir. July 21, 2008). The second Graham factor is “resolving the level of ordinary skill in the pertinent art.” Nowhere does the present Office Action resolve, or even attempt to resolve, “the level of ordinary skill in the pertinent art.”

The Patent Office “has the burden of showing a *prima facie* case of obviousness.” *In re Mayne*, 104 F.3d 1339, 1341 (Fed. Cir. 1997); *In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2008) (Fed. Cir. 2007). By failing to resolve the level of ordinary skill in the art, the Patent Office has failed to meet its burden of showing a *prima facie* case of obviousness. A *prima facie* case of obviousness cannot be established by totally failing to address and produce evidence relating to any of the *Graham* factors. Accordingly, the obviousness rejection of claims 33-34 is improper in view of the Patent Office’s failure to satisfy its evidentiary burden of establishing a *prima facie* case of obviousness.

The Patent Examiner asserts that “it would have been obvious to one skilled in the art to modify the Miller devices. Applicants are unable to respond to these conclusory assertions of what would have been obvious to a person of ordinary skill in the art or to a person having ordinary skill in the art because the Office Action fails to state what that level of skill is. Errors in resolving the level of ordinary skill in the art when evaluating obviousness are reversible errors. *Daiichi Sankyo Co. v. Apotex Inc.*, 84 U.S.P.Q.2d 1285, 1287 (Fed. Cir. 2007) (“The district court’s error in determining the level of ordinary skill in the art of the ‘741 patent tainted its obviousness analysis”). By failing to address this critical obviousness factor, the Office Action prevents the Applicants from determining whether the Patent Office has committed reversible error in its obviousness analysis.

Accordingly, Applicants are deprived of their due process right to respond to an obviousness rejection based upon all of the factual inquiries mandated by the Supreme Court in *Graham* and in *KSR*.

## **2. Rejections Under 35 U.S.C. §103(a)**

Notwithstanding the Patent Office's failure to establish a *prima facie* case of obviousness, as explained in Section G(1) above, Applicants respond below to the substantive Section 103 rejections in the Office Action as best as they can.

The teachings of a reference must be considered in their entirety. *BaU.S.C.h & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443,448 (Fed. Cir. 1986) ("it is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art"). Further, the Federal Circuit has held that it is "error to find obviousness where references diverge from and teach away from the invention at hand." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Evidence rebutting a *prima facie* case of obviousness can include evidence that the prior art teaches away from the claimed invention in any material respect. *In re Sullivan*, 498 F.3d at 1351. Obviousness cannot be determined without considering evidence attempting to rebut the *prima facie* case. *Id.* at 1353.

With respect to claims 33 and 34, claims 33 and 34 claim an exercise apparatus, comprising lockable left and right cranks. (Col. 5, lines 29-41 of the '956 Patent). Nothing in Miller discloses that crank 22 can be locked into a position or otherwise renders a lockable crank as claimed in claims 33 or 34 obvious. In fact, such a lock would make Miller inoperative. Thus, Miller taken alone does not render claims 33 or 34 obvious in view of the cited prior art.

Further Breunig fails to cure the deficiencies of Miller with respect to the features of claims 33-34. The Action notes that "Breunig teaches the use of an adjustment means for



altering the angle of inclination of a support.” Even assuming that Breunig discloses such an adjustment means, claims 33-34 do not claim an adjustment means, and changing of the angle of the support 43 in Breunig in no way discloses or suggests a lockable crank as required in claims 33 and 34. The Action further alleges that “It would have been obvious . . . providing an angle adjustable ramp for providing a greater amount of resistance due to gravity.” Even assuming that Breunig would have rendered obvious providing an angle adjustable ramp, claims 33 and 34 do not recite such a feature, and an angle adjustable ramp has nothing to do with the use of a lockable crank in combination with the other features of claims 33 and 34.

Thus, Miller and Breunig, whether taken alone or in combination, fail to disclose or suggest the use of lockable cranks in combination with the other features of claims 33 and 34, and claims 33 and 34 would not have been obvious at the time applicant’s invention was made.

### **III. CONCLUSION**

In view of the foregoing, acceptance for issue of all pending claims is respectfully requested.

Respectfully submitted,

12/10/2008

/GaryMaze/  
\_\_\_\_\_  
Gary R. Maze  
Reg. No. 42,851  
Duane Morris LLP  
3200 Southwest Freeway  
Suite 3150  
Houston, TX 77027  
Tel.: 713.402.3900  
Fax: 713.402.3901